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In re Application of: Mutsuyoshi ITO
Application No.: 09/898,068
Filed: July 5, 2001
For: SEMICONDUCTOR PACKAGE AND METHOD FOR PRODUCING THE SAME

DECISION ON PETITION

This is a decision on the petition filed on April 30, 2003, requesting reconsideration and withdrawal of the restriction requirement under 37 C.F.R. § 1.144.

The petition is **GRANTED**.

Petitioner asserts that the Requirement for Restriction of December 18, 2002, is improper because some of the claims subject to restriction were previously acted upon by the examiner, specifically claims 1-8. Petitioner asserts that no serious burden exist with the examination of the amended and the newly added claims, which were subject to restriction, since both method and product claims have received an office action on the merits.

Petitioner also asserts that the Requirement for Restriction of December 18, 2002, is improper because "the claims originally presented and acted upon by the Office on their merits determine the invention elected by an applicant in the application MPEP § 818.02(a)."

A review of the record indicates that a first action on the merits was issued on June 24, 2002. An amendment was filed by Petitioner on September 24, 2002. In response to this amendment, on December 18, 2002, the following restriction requirement was made:

> Restriction to one of the following inventions is required under 35 U.S.C. 121:
> I. Claims 2, 4 and 9-14, drawn to a product, classified in class 257, subclass 690.
> II. Claims 7, 8 and 15-20, drawn to a method, classified in class 438, subclass 106.

The inventions are distinct, each from the other because of the following reasons:

> Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the product as claimed can be made by another and materially different process such as a process of encapsulating the cavity before or during mounting the semiconductor device.

Because these inventions are distinct for the reasons given above and the search required for the invention of Group I is not required for Group II, restriction for examination purposes as indicated is proper.

Petitioner's remarks with respect to the lack of serious burden is found persuasive since the examiner did initially search and examine all originally filed claims, including both product and process claims. The amendment of September 24, 2002 merely placed originally filed claims 2, 4, 7 and 8 in independent form and cancelled claims 1, 3 and 5-6. Therefore, the scope of examination for these claims is no different than that already performed. The amendment did add new claims 9-20. Nevertheless, these claims are similar to the originally filed claims. The claims are not substantially more detailed than the originally filed claims and the inventions embodied in these claims is substantially the same as those originally presented and examined. Therefore, the scope of search and examination is substantially the same as before and no additional burden is caused by the amended claims.

As to the Petitioner's remarks with respect to the restriction requirement that "the claims originally presented and acted upon by the Office on their merits determine the invention elected by an applicant in the application MPEP § 818.02(a)"; this argument is not persuasive. Petitioner appears to be misinterpreting this section of the MPEP. This section relates to alternative methods of election by applicant, where restriction is proper. The section quoted by Petitioner does not relate to the propriety of a restriction requirement or the existence of burden and is unrelated to the issue at hand.

In summary, the restriction requirement of December 18, 20002, is hereby withdrawn and the application is being forwarded to examiner for action on the most recent amendment, December 19, 2003.

Sharon Gibson, Director
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